

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Redan Management Corp., Inc.

Serial No.: 76/101,636

Filed: August 2, 2000

Mark: THE WINNER'S CIRCLE
(AND DESIGN)

Law Office: 115

Examiner: Andrea P. Hammond

Docket No. 251803-3010

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Trademarks, Arlington, VA 22202-3515, on March 10, 2003.


Signature – Hui Chin Barnhill

REPLY TO EXAMINER'S ANSEER

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

This is in Reply to the Examiner's Answer in the above-referenced appeal.

Reply to Examiner's Objection

The Examiner has objected to Applicant's inclusion of a trademark search showing numerous marks that contain the wording "WINNER'S CIRCLE." The Examiner apparently concedes that Applicant's substantive argument is correct (*i.e.*, that

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TRADEMARK TRIAL AND
APPEAL BOARD



the term is relatively dilute and consequently has been improperly rejected by the Examiner), insofar as the Examiner has not substantively responded, but instead requests the Board to disregard it's contents.

First, the proper interpretation and evaluation of Applicant's mark is the responsibility of the Examiner. Integral to this evaluation process is examination of the mark by according the mark its proper scope. This evaluation process is not properly performed without a consideration of other registered marks. The Examiner obviously failed to properly construe the mark in the initial Office Action, and the Examiner is now urging the Board to ignore the evidence supplied by the Applicant, and therefore turn a blind eye to the Examiner's oversight.

Second, the TMEP is clear that the Examiner's initial action is to be complete ("The initial examination of an application by the examining attorney should be a *complete* examination." TMEP 704.01). The Examiner's failure to consider the numerous other registrations of marks that contain the term "Winner's Circle" embodies a clear error on the part of the Examiner to carryout her responsibility in the examination of this application. This failure on the part of the Examiner should not be endorsed or rewarded by the Board in refusing to consider the search offered by Applicant. Moreover, the content of this search does not embody new subject matter, but rather subject matter that was in the clear access/possession of the Examiner (i.e., the PTO database), and subject matter which **SHOULD** have been considered by the Examiner in accordance with her obligation to conduct a complete initial examination.

Further, in connection with the Final Office Action mailed by the Examiner, the Examiner attached (for the first time) results of a supplemental trademark search

performed by the Examiner. This information was attached ostensibly in response to Applicant's response the first Office Action. However, it underscores the fact that the initial examination was incomplete (insofar as this information was not previously presented to the Applicant). Further, the search itself was flawed in that it omitted numerous relevant marks.

Notwithstanding the inclusion of this new material, the Examiner made the second Office Action Final. In spite of the Examiner's disregard for her own obligations to perform a thorough and complete initial examination of Applicant's mark, and further in spite of the Examiner's flawed evaluation of Applicant's mark (i.e., the Examiner's failure to accord the proper scope to the cited registration and the term "Winner's Circle"), the Examiner now urges the Board to ignore these omissions and exclude substance (substance that the Examiner SHOULD have considered) that is highly relevant to a proper examination of Applicant's mark. The Board should not do so.

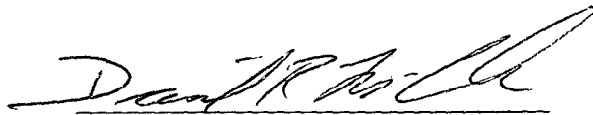
While the Board may wish to limit the weight that it accords to the search itself, it should not ignore even the most fundamental contents of the search (which are readily verifiable through the PTO's own database); namely, the number of registrations that include the term "Winner's Circle." Stated another way, in order to properly evaluate the merits of this appeal, the Board should consider the proper scope of the term "Winner's Circle." The Board cannot do so if it ignores information within the PTO's database that SHOULD have been considered by the Examiner during the examination of this application.

Reply to Substantive Rejections

Clearly, if the Board considers the proper scope of the term "Winner's Circle," then it should agree with Applicant's substantive argument (even the Examiner did not disagree). Notwithstanding, even if the Board disregards the search results that Applicant attached to its Appeal Brief, Applicant maintains that the Examiner's rejection is fundamentally flawed, and should be overturned by the Board. In this regard, the appearance of Applicant's mark (which includes the design) is significantly different and distinct from the cited word mark. Likewise, significant distinctions in the goods and channels of trade combine to sufficiently set apart Applicant's mark so as to avoid a likelihood of confusion. Applicant has amply set forth the relevant analysis on these issues in its Appeal Brief, and need not repeat them herein.

No fees are believed to be due in connection with this Substitute Appeal Brief. If, however, any fee is due, you are hereby authorized to charge any such fees to Deposit Account No. 20-0778.

Respectfully submitted,



Daniel R. McClure
Registration No. 38,962

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